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23. (newly added) The method according to claim 11

wherein the step of operating includes accepting identifying data from a user of an automated banking machine;

wherein the step of storing includes storing data corresponding to the identifying data in the transaction data object in software operating in the computer; and further comprising

(d) conducting a first transaction responsive to a user input to the machine, wherein conducting the first transaction includes accessing the data corresponding to the identifying data in the transaction data object.

24. (newly added) The method according to claim 11 and further comprising

(d) transferring data object data between a hand held device and the machine.

25. (newly added) The method according to claim 24 wherein the hand held device comprises a processor.

26. (newly added) The method according to claim 11 wherein the first device comprises a currency note dispenser.

27. (newly added) The apparatus according to claim 1 further including a hand held device, wherein the hand held device is operative to transfer data object data from or to the machine.

28. (newly added) The apparatus according to claim 27 wherein the hand held device comprises a processor.

29. (newly added) The apparatus according to claim 1 wherein the sheet dispenser comprises a currency note dispenser, and wherein the currency note dispenser is operative to dispense currency notes.

30. (newly added) Apparatus comprising:

an automated transaction machine including:

a sheet dispenser mechanism, wherein the sheet dispenser mechanism is adapted to selectively dispense sheets from the machine;

a computer in operative connection with the sheet dispenser mechanism, wherein the computer is adapted to receive mark up language documents, wherein the computer is adapted to operate responsive to at least one mark up language document to cause at least one sheet to be dispensed from the machine, and

wherein the computer is operative to store in a memory data representative of the dispense of the at least one sheet.

31. (newly added) The apparatus according to claim 30 further including a transaction data object, wherein the memory comprises the transaction data object, and wherein the transaction data object is operative to store therein data representative of the dispense of the at least one sheet.

32. (newly added) The apparatus according to claim 30 wherein the sheet dispenser mechanism comprises a currency note dispenser mechanism, and wherein the computer is adapted to operate responsive to the at least one mark up language document to cause at least one currency note to be dispensed from the machine.

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#### **The Claim Amendments**

Claims 1-32 are pending. The amendment to claim 6 has been made to correct a typing error. New claims 23-32 have been added. No new matter has been added. Support for the new claims may be found in the originally filed disclosure. An example of support for a hand held device may be found at Specification page 56, lines 3 and 17.

#### **Applicants Provisionally Elect With Traverse**

In response to the Office Action (“Action”) dated July 2, 2001 requiring restriction election, Applicants, as the requirement is best understood, provisionally elect with traverse

Group I (which includes at least claims 1-17). Applicants respectfully submit that Group I should also include all of the new claims. Reconsideration and withdrawal of said requirement is respectfully requested.

### **The Action Is Unclear**

A basis for insisting upon the restriction requirement is the Action's statement "In the instant case, automated financial data management such as using an identifier to secure data and facilitate data processing." However, this statement is incomplete and unclear.

The statement fails to clearly distinguish the Groups as independent and distinct from each other. The Action leaves Applicants the burden of properly responding to a confusing and improper restriction requirement. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

### **The Definitions Of The Alleged Groups Are Improper**

#### **Group II**

The Action indicates alleged Group II as drawn to "automated financial data management." However, Group II (claims 18-22) does not recite any "financial" or "management." These terms are not even found in the Group II claims. It appears that the Office is referring to an application other than Applicants. Therefore, the restriction requirement is based on an improper Group II definition. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

### The Alleged Groups I and II Are Not Distinct

The Action alleges that the inventions "are related as sub-combinations disclosed as usable together in a single combination." That is, the Action alleges that Groups I and II have separate utility. Apparently the Action's reasoning for separate utility is based on the Action's statement "In the instant case, automated financial data management such as using an identifier to secure data and facilitate data processing."

Applicants disagree. "The Examiner must show, by way of example, that one of the subcombinations has utility other than in the disclosed combination" and "The burden is on the examiner to provide an example" (MPEP 806.05 (d)). Applicants respectfully submit that the Action has not provided an appropriate example, as is required to sustain the requirement.

The Action has not shown that Group I is prevented from having utility in "automated financial data management." What prevents Group I from use in automated financial data management? There is no indication that the alleged separate utility attributed to Group II cannot also be performed with Group I. That is, Group I is not prevented from use with an "automated financial data management such as using an identifier to secure data and facilitate data processing." Furthermore, nothing in Group I prevents use of an "identifier." What exact language in Group I prevents the use of an identifier? Thus, Group I is able to use an identifier and perform the same utility attributed to Group II.

Additional support that Group I can have the same utilities as Group II can be found in claim 23. Claim 23, which depends from claim 11 of Group I, substantially corresponds to the subject matter of Group II claim 18. Therefore, Group I (e.g., claim 11) can have the same

utilities as Group II. Thus, the Action has not shown a utility of Group II that is "separately" usable from that of Group I.

"If Applicant proves or provides an argument, supported by facts, that the other use, suggested by the examiner, cannot be accomplished or is not reasonable, the burden is on the examiner to document a viable alternative use or withdraw the requirement." (MPEP 806.05 (d)). Applicants, in the reasons presented above, have shown that the alleged separate utility is not reasonable because the alleged utility is not separate. That is, the Action has not shown that the alleged utility of Group II is separate (different) from a Group I utility. Group I can practice the same utility as Group II. Therefore, it is respectfully requested that the restriction requirement be withdrawn.

Furthermore, Applicants respectfully submit that the search for claim 18 (Group II ) would be the same as the search for claim 23 (Group I). Thus, there would not be a serious (or undue) burden on the examiner if restriction is not required. It follows that the examiner is required to search and examine the entire application (MPEP § 803).

#### **A Restriction Based On Art Unit Numbering Is Improper**

The Action alleges that a restriction requirement is proper because "the search required for Group 2164 is not required for Group 2161." This is not a valid basis for restriction requirement. It is unclear how Art Unit numbering can be used as a basis for restriction requirement. Applicants respectfully submit that there is nothing within the statutes, rules, or Office procedures for such basis.

**Valid Reasons For Insisting On Restriction Have Not Been Provided**

In making a restriction requirement, it is understood that the initial burden is on the Office to establish a *prima facie* case that: (a) the claimed inventions are independent or distinct and (b) there would be a serious (or undue) burden on the examiner if restriction is not required (MPEP § 803).

Furthermore, MPEP § 808 indicates that with regard to every requirement to restrict the Office has the burden of showing two aspects: (1) the reasons (as distinguished from the mere statement of conclusion) why the inventions *as claimed* are either independent or distinct, and (2) the reasons for insisting upon restriction therebetween.

As shown herein by Applicants, these burdens have not been met. On this basis it is respectfully submitted that the restriction requirement should be withdrawn.

**The Restriction Requirement Is Without Legal Basis**

Applicants also respectfully wish to point out that the Action fails to state a legally sufficient basis for imposing a restriction requirement. The Action indicates that the restriction requirement is solely based on a showing of the alleged inventions being “distinct.” The statutory authority for the Patent Office to impose a restriction requirement is found in 35 U.S.C. § 121. The statute expressly states that before the Patent Office may require restriction, the inventions must be both “independent” and “distinct.” The regulations that have been promulgated pursuant to this statute, 37 C.F.R. § 1.141 and 37 C.F.R. § 1.142, both expressly state that before a restriction requirement may be imposed the inventions claimed must be both independent and distinct.

In the Action, there are only unsupported assertions that the sets of claims are “distinct.” There are no assertions that the sets of claims are “independent”, as is required. This standard does not comply with the statutory requirements. Therefore, the standard used in the Action for seeking to impose a restriction requirement is legally incorrect due to noncompliance with the clear wording of both the statute and the regulations promulgated thereunder. The application of such an incorrect legal standard is arbitrary, capricious, and contrary to law in violation of the Administrative Procedures Act.

Furthermore the Patent Office has acknowledged that before claimed inventions can be considered to be “independent” the inventions must be unconnected in design, operation, or effect. MPEP § 802.01. All the claims directed to Applicants’ invention are related in design, operation, and effect. Thus, the statutory requirements are not met and no restriction requirement may be imposed.